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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,288	12/07/2000	Laurent Chevalet	PF83PCTSEQ/D	3732

25666 7590 10/01/2002

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EXAMINER

KATCHEVES, KONSTANTINA T

ART UNIT PAPER NUMBER

1636

DATE MAILED: 10/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,288

Applicant(s)

CHEVALET ET AL.

Examiner

Konstantina T. Katcheves

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-21 are pending in the present application.

Response to Amendment

The rejection of claims 1-11 under 35 U.S.C. 103(a) as being unpatentable over Warne et al. in view of Yanofsky et al. has been withdrawn in view of Applicant's arguments and amendment filed 28 August 2001.

The rejections of claims 1-21 under 35 U.S.C. 112, second paragraph have been withdrawn in view of Applicant's arguments and amendments filed 28 August 2001.

Claims 1-9, 12-14 and 17 stand rejected under 35 U.S.C. 112, first paragraph for the reasons of record set forth in the Office Action mailed 23 May 2001.

Response to Arguments

Claims 1-9, 12-14 and 17 stand rejected and claims 10, 11, 15, 16 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The written description requirement is established by 35 U.S.C. 112, first paragraph which states that the: "*specification* shall contain a written description of the invention . . . [emphasis added]." The written description requirement has been well established and characterized in the case law. A specification must convey to one of skill in the art that "as of the filing date sought, [the inventor] was in possession of the invention." See *Vas Cath v.*

Mahurkar 935 F.2d 1555, 1560 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Applicant may show that he is in "possession" of the invention claimed by describing the invention with all of its claimed limitations "by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." See *Lockwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Claims 10, 11, 15, 16 and 18-21 are included in the present rejection because they also read on fragments and variants of TnaA such that a rejection under the written description requirement is appropriate for the reason of record and those set forth below.

Applicant's arguments filed 8 July 2002 have been fully considered but they are not persuasive. Applicant argues that it is "clearly stated in the description that the TnaA sequence is modified so as to result in the loss of tryptophanase activity," and that "biologically active fragments of the TrpR are defined in the description as fragments which keep their repressor activity." However, MPEP 2163(I)(A) clearly addresses this issue:

A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.

A generic statement . . . without more, is not an adequate written description of the genus because it does not distinguish the claimed genus from others, except by function." See *University of California v. Eli Lilly and co.* 119 F.3d 1559, 43 USPQ2d 1398 (1997). Applicant has not specifically defined or described any structural characteristics commonly possessed by TnaA or TrpR so that one of skill in the art would recognize that Applicant was in possession of TnaA sequences lacking tryptophanase activity or biologically active TrpR sequences. Applicant

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has still failed to provide a description of what motifs or sequence confer activity to TnaA or TrpR sequences. For these reasons, Applicant's arguments are not persuasive.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konstantina Katcheves whose telephone number is (703) 305-1999. The examiner can normally be reached on Monday through Friday 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3388.

Konstantina Katcheves
October 1, 2002


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